

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Limor Schweitzer

Application No.: 09/879,682

Group No.: 3693

Filed: 06/11/2001

Examiner: Apple, K.

For: SYSTEM, METHOD AND COMPUTER PROGRAM PRODUCT FOR PREPAID AND WIRELESS VOICE COMMUNICATION AND IP SERVICES

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**TRANSMITTAL OF APPEAL BRIEF
(PATENT APPLICATION--37 C.F.R. § 41.37)**

1. Transmitted herewith, is the APPEAL BRIEF in this application, with respect to the Notice of Appeal filed on February 26, 2007.

2. STATUS OF APPLICANT

This application is on behalf of other than a small entity.

3. FEE FOR FILING APPEAL BRIEF

Pursuant to 37 C.F.R. § 41.20(b)(2), the fee for filing the Appeal Brief is:

other than a small entity \$500.00

Appeal Brief fee due \$500.00

4. EXTENSION OF TERM

The proceedings herein are for a patent application and the provisions of 37 C.F.R. § 1.136 apply.

Applicant believes that no extension of term is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

5. TOTAL FEE DUE

The total fee due is:

Appeal brief fee \$500.00
Extension fee (if any) \$0.00

TOTAL FEE DUE \$500.00

6. FEE PAYMENT

Authorization is hereby made to charge the amount of \$500.00 to Deposit Account No. 50-1351 (Order No. AMDCP005).

7. FEE DEFICIENCY

If any additional extension and/or fee is required, and if any additional fee for claims is required, charge Deposit Account No. 50-1351 (Order No. AMDCP005).

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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:)	
)	
Schweitzer, Limor)	Group Art Unit: 3693
)	
Application No. 09/879,682)	Examiner: Apple, Kirsten Sachwitz
)	
Filed: 06/11/2001)	Date: 04/26/2007
)	
For: SYSTEM, METHOD AND COMPUTER)	
PROGRAM PRODUCT FOR PREPAID)	
AND WIRELESS VOICE)	
COMMUNICATION AND IP SERVICES)	
)	
)	

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ATTENTION: Board of Patent Appeals and Interferences

APPEAL BRIEF (37 C.F.R. § 41.37)

This brief is in furtherance of the Notice of Appeal, filed in this case on 02/26/2007.

The fees required under § 1.17, and any required petition for extension of time for filing this brief and fees therefor, are dealt with in the accompanying TRANSMITTAL OF APPEAL BRIEF.

This brief contains these items under the following headings, and in the order set forth below (37 C.F.R. § 41.37(c)(i)):

- I REAL PARTY IN INTEREST
- II RELATED APPEALS AND INTERFERENCES
- III STATUS OF CLAIMS
- IV STATUS OF AMENDMENTS
- V SUMMARY OF CLAIMED SUBJECT MATTER

I REAL PARTY IN INTEREST (37 C.F.R. § 41.37(c)(1)(i))

The real party in interest in this appeal is Amdocs (Israel) Ltd.

II RELATED APPEALS AND INTERFERENCES (37 C.F.R. § 41.37(c) (1)(ii))

With respect to other prior or pending appeals, interferences, or related judicial proceedings that will directly affect, or be directly affected by, or have a bearing on the Board's decision in the pending appeal, there are no other such appeals, interferences, or related judicial proceedings.

A Related Proceedings Appendix is appended hereto.

III STATUS OF CLAIMS (37 C.F.R. § 41.37(c) (1)(iii))

A. TOTAL NUMBER OF CLAIMS IN APPLICATION

Claims in the application are: 1-36

B. STATUS OF ALL THE CLAIMS IN APPLICATION

1. Claims withdrawn from consideration: None
2. Claims pending: 1-36
3. Claims allowed: None
4. Claims rejected: 1-36
5. Claims cancelled: None

C. CLAIMS ON APPEAL

The claims on appeal are: 1-36

See additional status information in the Appendix of Claims.

IV STATUS OF AMENDMENTS (37 C.F.R. § 41.37(c)(1)(iv))

As to the status of any amendment filed subsequent to final rejection, an amendment was filed after a final rejection on 11/21/2006, which was not entered by the Examiner, as noted in the Advisory Action mailed 01/16/2007.

V SUMMARY OF CLAIMED SUBJECT MATTER (37 C.F.R. § 41.37(c)(1)(v))

With respect to a summary of Claim 1, as shown in Figure 2, a method for providing a digital wallet for Internet Protocol (IP) usage utilizing a wireless network is provided. In use, prior to allowing wireless network voice communication and IP usage over a wireless network, a request is received for a pre-paid debit account including payment therefore (e.g. see item 202 of Figure 2, etc.). In addition, prior to allowing the wireless network voice communication and the IP usage over the wireless network, the pre-paid debit account is enabled in response to the request (e.g. see item 204 of Figure 2, etc.). Further, payment for the wireless network voice communication over the wireless network is collected by billing against the pre-paid debit account (e.g. see item 206 of Figure 2, etc.). Moreover, payment for the IP usage is collected by billing against the pre-paid debit account, where the IP usage is carried out using the wireless network (e.g. see item 208 of Figure 2, etc.). See, for example, page 5, lines 3-10; and page 10, lines 14-21 et al.

With respect to a summary of Claim 18, as shown in Figure 2, a computer program product embodied on a tangible computer readable medium for providing a digital wallet for Internet Protocol (IP) usage utilizing a wireless network is provided. Computer code is included for receiving a request for a pre-paid debit account including payment therefore (e.g. see item 202 of Figure 2, etc.), prior to allowing wireless network voice communication and IP usage over a wireless network. In addition, computer code is included for enabling the pre-paid debit account in response to the request (e.g. see item 204 of Figure 2, etc.), prior to allowing the wireless network voice communication and the IP usage over the wireless network. Further, computer code is included for collecting payment for the wireless network voice communication over the wireless network by billing against the pre-paid debit account (e.g. see item 206 of Figure 2, etc.). Moreover, computer code is included for collecting payment for the IP usage by billing against the pre-paid debit account, where the IP usage is carried out using the wireless network (e.g. see item 208 of Figure 2, etc.). See, for example, page 5, lines 3-10; and page 10, lines 14-21 et al.

With respect to a summary of Claim 35, as shown in Figure 2, a system is provided including a computer readable medium for providing a digital wallet for Internet Protocol (IP) usage

utilizing a wireless network. Logic is included for receiving a request for a pre-paid debit account including payment therefore (e.g. see item 202 of Figure 2, etc.), prior to allowing wireless network voice communication and IP usage over a wireless network. In addition, logic is included for enabling the pre-paid debit account in response to the request (e.g. see item 204 of Figure 2, etc.), prior to allowing the wireless network voice communication and the IP usage over the wireless network. Further, logic is included for collecting payment for the wireless network voice communication over the wireless network by billing against the pre-paid debit account (e.g. see item 206 of Figure 2, etc.). Moreover, logic is included for collecting payment for the IP usage by billing against the pre-paid debit account, where the IP usage is carried out using the wireless network (e.g. see item 208 of Figure 2, etc.). See, for example, page 5, lines 3-10; and page 10, lines 14-21 et al.

With respect to a summary of Claim 36, as shown in Figure 2, a method for providing a digital wallet for Internet Protocol (IP) usage utilizing a wireless network is provided. In use, prior to allowing wireless network voice communication and IP usage over a wireless network, a request is received for a pre-paid debit account from a user utilizing a mobile communication unit. In addition, prior to allowing the wireless network voice communication and the IP usage over the wireless network, an account identifier associated with a previous account of the user which is adapted solely for voice communications is received. Further, prior to allowing the wireless network voice communication and the IP usage over the wireless network, an identity of the user is authenticated. Moreover, prior to allowing the wireless network voice communication and the IP usage over the wireless network, a pre-paid debit account is enabled (e.g. see item 204 of Figure 2, etc.). Still yet, prior to allowing the wireless network voice communication and the IP usage over the wireless network, monies associated with the previous account are transferred to the pre-paid debit account. Also, payment for the wireless network voice communication over the wireless network is collected by billing against the pre-paid debit account (e.g. see item 206 of Figure 2, etc.). Additionally, payment for the IP usage is collected by billing against the pre-paid debit account, where the IP usage is carried out using the wireless network (e.g. see item 208 of Figure 2, etc.). See, for example, page 5, lines 3-14; page 5, line 30-page 6, line 1; and page 10, lines 14-20 et al.

Of course, the above citations are merely examples of the above claim language and should not be construed as limiting in any manner.

VI GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL (37 C.F.R. § 41.37(c)(1)(vi))

Following, under each issue listed, is a concise statement setting forth the corresponding ground of rejection.

Issue # 1: The Examiner has rejected Claim 7 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which appellant regards as the invention.

Issue #2: The Examiner has rejected Claims 1-11 and 18-28 under 35 U.S.C. 103(a) as being unpatentable over Hultgren (U.S. Patent No. 6,868,391), in view of Official Notice.

Issue #3: The Examiner has rejected Claims 12-15 and 29-32 under 35 U.S.C. 103(a) as being unpatentable over Hultgren (U.S. Patent No. 6,868,391), in view of Official Notice, and in further view of Foladare (U.S. Patent No. 5,914,472).

Issue #4: The Examiner has rejected Claims 16-17 and 33-34 under 35 U.S.C. 103(a) as being unpatentable over Hultgren (U.S. Patent No. 6,868,391), in view of Official Notice, in view of Foladare (U.S. Patent No. 5,914,472), and in further view of Holm-Blagg (U.S. Patent Application No. 2004/0030657).

Issue #5: The Examiner has failed to address Claims 35 and 36.

VII ARGUMENT (37 C.F.R. § 41.37(c)(1)(vii))

The claims of the groups noted below do not stand or fall together. In the present section, appellant explains why the claims of each group are believed to be separately patentable.

Issue # 1:

The Examiner has rejected Claim 7 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which appellant regards as the invention.

Group #1: Claim 7

With respect to Claim 7, the Examiner takes issue with appellant's claimed "previous [pre-paid] debit account" since it is allegedly unclear. Further, the Examiner states that the claim will be interpreted as "[t]ransferring the payment from a first existing customer bank debit account before enabling the pre-paid second phone debit account in response to the request." In addition, the Examiner argues that '[i]f the [appellant] is trying to explain that many users will have a first already existing debit account with a bank that they will use to establish the "mobile phone usage or second account" then this should be explained in more detail.'

Appellant respectfully disagrees with the foregoing rejection, and asserts that it is clear, from the claim language itself, that the "previous pre-paid debit account," as disclosed and claimed by appellant, should be interpreted as a pre-paid debit account that was previously established. See, for example, Page 10, lines 14-21 of the specification as originally filed which clearly states that "the user may transfer payment from another pre-paid debit account such as one previously established."

In the Office Action mailed 8/24/2006, the Examiner has argued that appellant's above arguments are "still... unclear to the [E]xaminer." The Examiner has argued that '[i]f the [appellant] is trying to explain that many users will have a first already existing debit account

with a bank that they will use to establish the “mobile phone usage or second account” then this should be explained in more detail.’

Appellant again respectfully asserts that appellant clearly claims “receiving a request for a pre-paid debit account including payment therefor” (see Claim 1 for context-emphasis added) and “transferring the payment from a previous pre-paid debit account before enabling the pre-paid debit account in response to the request” (Claim 7-emphasis added). Thus, clearly appellant claims “transferring...payment [for a pre-paid debit account] from a previous pre-paid debit account,” in the context claimed. Further, appellant again respectfully points out Page 10, lines 14-21 of the specification as originally filed, which further provides an example of such claim language in that “the user may transfer payment from another pre-paid debit account such as one previously established.”

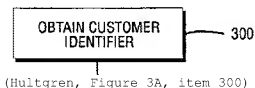
Of course, such citations are set forth by way of example only and should not be construed as limiting to the claims in any manner.

Issue #2:

The Examiner has rejected Claims 1-11 and 18-28 under 35 U.S.C. 103(a) as being unpatentable over Hultgren (U.S. Patent No. 6,868,391), in view of Official Notice.

Group #1: Claims 1, 3-6, 11, 18, 20-23, and 28

With respect to the independent claims, the Examiner has relied on item 300 in Figure 3A from Hultgren, as excerpted below, to make a prior art showing of appellant’s claimed “prior to allowing wireless network voice communication and IP usage over a wireless network, receiving a request for a pre-paid debit account including payment therefor” (see this or similar, but not necessarily identical language in the independent claims).



"At telepay TSN 30, upon initially handling the call customer communications, module 202 obtains a customer identifier (e.g., customer directory number) from the call signaling which sets up the call (see step 300 in FIG. 3A)." (Hultgren, Col. 6, lines 22-26, not specifically cited - emphasis added).

Appellant respectfully asserts that item 300 in Figure 3A from Hultgren simply teaches that "module 202 obtains a customer identifier (e.g., customer directory number) from the call signaling which sets up the call (see step 300 in FIG. 3A)" (emphasis added). However, simply disclosing that a customer identifier is obtained, in no way suggests "prior to allowing wireless network voice communication and IP usage over a wireless network, receiving a request for a pre-paid debit account including payment therefor" (emphasis added), as claimed by appellant.

In the Office Action mailed 08/24/2006, the Examiner has argued that "it is inherent that [you] would...obtain a customer identification for those that request the payment transfer service or debit account." In addition, the Examiner has argued that "'receiving a request for a debit account" would be included in practically all prior art that includes a debit account, [since] you would not establish an account unless the customer request[ed] it.'

Again, appellant respectfully disagrees, and emphasizes that simply disclosing that a customer identifier is obtained, in no way suggests "prior to allowing wireless network voice communication and IP usage over a wireless network, receiving a request for a pre-paid debit account including payment therefor" (emphasis added), as claimed by appellant. In fact, appellant respectfully points out that Hultgren actually discloses that "the customer merely dials on customer mobile station 60 the directory number of the telepay TSN 30," that the "call is routed through PSTN 50, which includes mobile base station (BS) 52," and that "upon initially handling the call customer communications, module 202 obtains a customer identifier" (Col. 6, lines 18-26).

Clearly, Hultgren discloses a situation where a customer utilizes a mobile station 60 to call a TSN 30, where such call is routed through a PSTN 50 that includes a mobile base station 52, which does not meet, and even *teaches away* from, appellant's claimed "prior to allowing wireless network voice communication and IP usage over a wireless network, receiving a request

for a pre-paid debit account including payment therefor” (emphasis added), as claimed by appellant.

Thus, even if “it is inherent that [you] would...obtain a customer identification for those that request the payment transfer service or debit account,” as alleged by the Examiner, Hultgren teaches obtaining such customer identification via a call made from a customer mobile station, which in fact *teaches away* from appellant’s specific claim language, as noted above. Appellant respectfully emphasizes that a *prima facie* case of obviousness may also be rebutted by showing that the art, in any material respect, teaches away from the claimed invention. *In re Geisler*, 116 F.3d 1465, 1471, 43 USPQ2d 1362, 1366 (Fed. Cir. 1997).

Further, the Examiner’s purported knowledge that “you would not establish an account unless the customer request it” (emphasis added) is not inherent in the method and apparatus of Hultgren, which simply discloses “a service node (TSN) which facilitates payment/transfer from a customer account of a customer financial institution to a merchant account of a merchant financial institution” (Col. 1, lines 55-58 – emphasis added). Clearly, facilitating payment between a customer account and a merchant account, as in Hultgren, fails to inherently suggest a situation where “prior to allowing wireless network voice communication and IP usage over a wireless network,...a request for a pre-paid debit account including payment therefore [is received]” (emphasis added), in the manner as claimed by appellant.

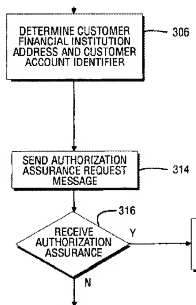
It appears that the Examiner has relied on an inherency/Official Notice argument regarding the above emphasized claim limitations. Regarding the inherency argument, appellant respectfully asserts that the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). “To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’” *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

In view of the arguments made hereinabove, any inherency argument has been adequately rebutted, and a notice of allowance or a specific prior art showing of such claim features, in combination with the remaining claim elements is respectfully requested. (See MPEP 2112)

Further, regarding the Examiner's general reliance on Official Notice, appellant again points out the remarks above that clearly show the manner in which appellant's claim limitations further distinguish Hultgren, and thus formally requests a specific showing of the subject matter in ALL of the claims in any future action. Note excerpt from MPEP below.

"If the [appellant] traverses such an [Official Notice] assertion the examiner should cite a reference in support of his or her position." See MPEP 2144.03.

Furthermore, with respect to the independent claims, the Examiner has relied on items 306, 314, and 316 in Figure 3A from Hultgren, as excerpted below, to make a prior art showing of appellant's claimed "prior to allowing the wireless network voice communication and the IP usage over the wireless network, enabling the pre-paid debit account in response to the request" (see this or similar, but not necessarily identical language in the independent claims).



(Hultgren, Figure 3A, items 306, 314, and 316)

"At step 306, telepay TSN 30 determines the customer financial institution address and the customer account identifier at the customer financial institution. In particular, at step 306 the transfer coordination module 206 sends to the financial institution communication module 208 a signal which includes the current transaction code, the current customer identifier, and (optionally) the transaction amount." (Col. 6, line 66 to Col. 7, line 5, not specifically cited - emphasis added)

"The authorization assurance request message is routed by customer financial institution interface 208-1 over data network N to the customer financial institution address obtained at step 314. The authorization assurance request message, indicated as event E5 in FIG. 1, includes the transaction code, the customer account identifier, the transaction amount, and a message type code." (Col. 7, lines 24-30, not specifically cited - emphasis added)

"As indicated by step 316 of FIG. 3A, if the authorization assurance message is negative (indicating that authorization is not granted), an invalid transaction notification is sent to customer mobile station 60 (see step 318). Otherwise, as shown by step 320, the customer financial institution address and customer account identifier obtained from step 306, along with an indication of receipt of a positive authorization assurance message, are stored in the record for the current transaction in transaction database 220." (Col. 7, lines 39-47, not specifically cited - emphasis added)

Appellant respectfully asserts that items 306, 314 and 316 in Figure 3A from Hultgren relied upon by the Examiner merely disclose "determin[ing] the customer financial institution address and the customer account identifier at the customer financial institution" (emphasis added). Hultgren also discloses that "[t]he authorization assurance request message is routed ... to the customer financial institution address obtained at step 314" (emphasis added). In addition, Hultgren discloses receiving "the authorization assurance message" in step 316.

However, determining the customer financial institution address and the customer account identifier in order to route the authorization assurance request message, as in Hultgren, simply fails to disclose any sort of enabling, let alone "enabling the pre-paid debit account in response to the request" (emphasis added), as claimed by appellant. Moreover, determining the customer financial institution address and the customer account identifier in order to route the authorization assurance request message, as in Hultgren, in no way suggests "prior to allowing the wireless network voice communication and the IP usage over the wireless network, enabling the pre-paid debit account in response to the request" (emphasis added), as claimed by appellant.

In the Office Action mailed 08/24/2006, the Examiner has argued that “items 306, 314 & 316...outline enabling the process” and that the Examiner “is interpreting the broadest reasonable interpretation and these step[s] certainly would include enabling the process.”

First, appellant respectfully disagrees and asserts that appellant claims “enabling the pre-paid debit account,” and not simply “enabling a process” where such process simply “assure[s] that the customer account has sufficient funds to cover the transaction amount prior to effecting the transaction” (see Col. 7, lines 18-20), as noted by the Examiner. Second, appellant refers to the arguments made hereinabove with respect to items 306, 314, and 316 in Figure 3A from Hultgren and respectfully asserts that determining the customer financial institution address and the customer account identifier in order to route the authorization assurance request message, as in Hultgren, in no way suggests “prior to allowing the wireless network voice communication and the IP usage over the wireless network, enabling the pre-paid debit account in response to the request” (emphasis added), as claimed by appellant.

Furthermore, with respect to the independent claims, the Examiner has admitted that Hultgren does not specifically disclose appellant’s claimed “payment for the wireless network voice communication” (see this or similar, but not necessarily identical language in the independent claims). However, the Examiner has argued that it is “inherent that any utility including a mobile phone company is disclosed in Hultgren” and that ‘Hultgren specifically uses the example of “utility bill, for example” (column 4, line 50).’ Appellant respectfully disagrees.

Also, in the Office Action mailed 08/24/2006, the Examiner argues that “in further review of the prior art [the Examiner] believe[s] that payment of phone service is included directly in the reference and inherent in that it clearly states ‘utility bill, for example’ (column 4, line 50).” In addition, the Examiner argues that “because Hultgren has additional features is not an indication that it is teaching away [from] the reference.”

Appellant respectfully disagrees, and asserts that disclosing a situation where if a “customer wants to pay...for a good or service, or for payment of a bill or invoice (such as a utility bill, for example)...[then] the customer merely dials the directory number of the telepay” (see Col. 4,

lines 48-50 of Hultgren – emphasis added), does not specifically suggest “wireless network voice communication,” as claimed by appellant.

Again, in view of the arguments made hereinabove, appellant formally requests a specific showing of the subject matter in ALL of the claims in any future action.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on appellant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir.1991).

Appellant respectfully asserts that at least the third element of the *prima facie* case of obviousness has not been met, since the prior art reference excerpts, as relied upon by the Examiner, fail to teach or suggest all of the claim limitations, as noted above.

Group #2: Claims 2 and 19

With respect to Claim 2 et al., the Examiner has relied on item 60 in Figure 1 from Hultgren, with the description thereof excerpted below, to make a prior art showing of appellant’s claimed technique “wherein the request is received via a mobile cellular hand set, and the pre-paid debit account is enabled by a human operator.”

“The TSN (30) acquires a merchant identifier and transaction amount from a customer mobile station (60). The TSN (30) sends a transaction verification request message to both the customer mobile station (60) and the merchant terminal (70).” (Abstract – not specifically cited – emphasis added)

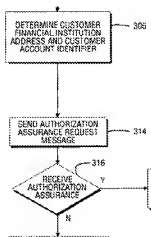
Appellant respectfully asserts that item 60 in Figure 1 from Hultgren merely discloses a customer mobile station that sends a merchant identifier and transaction amount to the TSN and, in return,

the customer mobile station receives a transaction verification request message from the TSN. However, the mere disclosure of a customer mobile station that sends a merchant identifier and transaction amount, and receives a transaction verification request message, as in Hultgren, in no way suggests any sort of enabling, let alone a specific technique “wherein the request is received via a mobile cellular hand set, and the pre-paid debit account is enabled by a human operator” (emphasis added), as claimed by appellant.

Appellant respectfully asserts that at least the third element of the *prima facie* case of obviousness has not been met, since the prior art reference excerpts, as relied upon by the Examiner, fail to teach or suggest all of the claim limitations, as noted above.

Group #3: Claims 7 and 24

With respect to Claim 7 et al., the Examiner has relied on items 306, 314, and 316 in Figure 3A from Hultgren, as excerpted below, to make a prior art showing of appellant’s claimed “transferring the payment from a previous pre-paid debit account before enabling the pre-paid debit account in response to the request.”



(Hultgren, Figure 3A, items 306, 314, and 316)

Appellant respectfully asserts that the description of items 306, 314, and 316 in Figure 3A from Hultgren merely disclose “determin[ing] the customer financial institution address and the customer account identifier at the customer financial institution” (emphasis added). Hultgren also discloses that “[t]he authorization assurance request message is routed ... to the customer

financial institution address obtained at step 314” (emphasis added). In addition, Hultgren discloses receiving “the authorization assurance message” in step 316. However, items 306, 314, and 316 in Figure 3A from Hultgren simply fail to disclose a technique for “transferring the payment from a previous pre-paid debit account before enabling the pre-paid debit account in response to the request” (emphasis added), as claimed by appellant. The items referenced in Figure 3A above simply fail to even suggest any type of “previous pre-paid debit account,” as claimed by appellant.

Appellant respectfully asserts that at least the third element of the *prima facie* case of obviousness has not been met, since the prior art reference excerpts, as relied upon by the Examiner, fail to teach or suggest all of the claim limitations, as noted above.

Group #4: Claims 8 and 25

With respect to Claim 8 et al., the Examiner has relied on the following excerpt from Hultgren to make a prior art showing of appellant’s claimed technique “wherein a balance of the pre-paid debit account is updated in real-time.”

“Step 348 also shows transfer coordination module 206 sending a funds transfer requested notification message to merchant financial institution 90 over data network N. The funds transfer requested notification message alerts institution 90 to expect to receive eventually a transfer of the transaction amount to the merchant account maintained at merchant financial institution 90 from the customer financial institution 80. Such funds transfer requested notification message is depicted as event E14 in FIG. 1.” (Col. 9, lines 27-35 – not specifically cited – emphasis added).

“Customer financial institution 80 can immediately transfer funds from the customer account to the merchant account at merchant financial institution 90, e.g., in accordance with usual banking procedures. For sake of simplicity, such transfer is depicted in FIG. 1 as event E15. As an option, customer financial institution 80 can also send to telepay TSN 30 a confirmation that the funds have been transferred from customer financial institution 80 to merchant financial institution 90. Merchant financial institution 90 in turn credits the merchant account with the transaction amount, which credit may possibly occur after a “float” delay.” (Col. 9, lines 36-47 – emphasis added)

Appellant respectfully asserts that the excerpt relied upon by the Examiner merely teaches that the “[c]ustomer financial institution 80 can immediately transfer funds from the customer

account to the merchant account at merchant financial institution 90” (emphasis added). Further, Hultgren teaches that “institution 90 [should] expect to receive eventually a transfer of the transaction amount to the merchant account maintained at merchant financial institution 90 from the customer financial institution 80” (emphasis added). However, the mere disclosure that the funds can be immediately transferred from the customer account to the merchant account and that the merchant account should eventually receive the transfer of the transaction amount, as in Hultgren, fails to suggest a technique “wherein a balance of the pre-paid debit account is updated in real-time” (emphasis added), as claimed. Clearly, an immediate transfer from a customer account to a merchant account, as in Hultgren, fails to suggest that “a balance of the pre-paid debit account is updated in real-time” (emphasis added), as claimed by appellant.

Appellant respectfully asserts that at least the third element of the *prima facie* case of obviousness has not been met, since the prior art reference excerpts, as relied upon by the Examiner, fail to teach or suggest all of the claim limitations, as noted above.

Group #5: Claims 9 and 26

With respect to Claim 9 et al., the Examiner has relied on the following excerpt from Hultgren to make a prior art showing of appellant’s claimed technique “wherein an alert is sent to a user upon the pre-paid debit account falling below a predetermined amount.”

“As indicated by step 316 of FIG. 3A, if the authorization assurance message is negative (indicating that authorization is not granted), an invalid transaction notification is sent to customer mobile station 60 (see step 318). Otherwise, as shown by step 320, the customer financial institution address and customer account identifier obtained from step 306, along with an indication of receipt of a positive authorization assurance message, are stored in the record for the current transaction in transaction database 220.” (Hultgren, Col. 7, lines 40-47 - emphasis added)

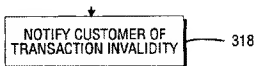
Appellant respectfully asserts that the excerpt from Hultgren relied upon by the Examiner merely suggests that “if the authorization assurance message is negative (indicating that authorization is not granted), an invalid transaction notification is sent to customer mobile station 60” (emphasis added). Appellant notes, however, that such authorization assurance message is in response to a requested transaction. Thus, appellant respectfully asserts that sending an invalid transaction

notification when the authorization assurance message is negative, in the context of Hultgren, fails to disclose a technique “wherein an alert is sent to a user upon the pre-paid debit account falling below a predetermined amount” (emphasis added), as claimed by appellant.

Appellant respectfully asserts that at least the third element of the *prima facie* case of obviousness has not been met, since the prior art reference excerpts, as relied upon by the Examiner, fail to teach or suggest all of the claim limitations, as noted above.

Group #6: Claims 10 and 27

With respect to Claim 10 et al., the Examiner has relied on item 318 in Figure 3A from Hultgren, as excerpted below, to make a prior art showing of appellant’s claimed technique “wherein the wireless network voice communication and the IP usage is discontinued upon the pre-paid debit account falling below a predetermined amount.”



(Hultgren, Figure 3A, item 318)

“As indicated by step 316 of FIG. 3A, if the authorization assurance message is negative (indicating that authorization is not granted), an invalid transaction notification is sent to customer mobile station 60 (see step 318).” (Hultgren, Col. 7, lines 39-42, not specifically cited – emphasis added)

Appellant respectfully asserts that the item and figure from Hultgren relied upon by the Examiner merely teach that “if the authorization assurance message is negative (indicating that authorization is not granted), an invalid transaction notification is sent to customer mobile station 60 (see step 318).” However, sending an invalid transaction notification when the authorization assurance message is negative, as in Hultgren, fails to even suggest a technique “wherein the wireless network voice communication and the IP usage is discontinued upon the pre-paid debit account falling below a predetermined amount” (emphasis added), as claimed by appellant.

Appellant respectfully asserts that at least the third element of the *prima facie* case of obviousness has not been met, since the prior art reference excerpts, as relied upon by the Examiner, fail to teach or suggest all of the claim limitations, as noted above.

Issue #3:

The Examiner has rejected Claims 12-15 and 29-32 under 35 U.S.C. 103(a) as being unpatentable over Hultgren (U.S. Patent No. 6,868,391), in view of Official Notice, and in further view of Foladare (U.S. Patent No. 5,914,472).

Group #1: Claims 12 and 29

With respect to Claim 12 et al., the Examiner has relied upon item 104 in Figure 1 from Foladare, the description thereof excerpted below, to make a prior art showing of appellant's claimed "limiting the wireless network voice communication and the IP usage based on a user-defined threshold."

"The account holder, who is the responsible person for the account, may also set a spending limit on the ancillary card, thereby restricting the spending power of the ancillary card user." (Foladare, Col. 4, lines 3-6, not specifically cited - emphasis added)

Appellant respectfully asserts that item 104 from Figure 1 merely indicates that the receiver checks to see the amount of credit available for the account holder. In addition, Foladare teaches that "[t]he account holder... may...set a spending limit on the ancillary card." However, the mere disclosure that an account holder may set a spending limit on the ancillary card, as in Foladare, in no way suggests "limiting the wireless network voice communication and the IP usage based on a user-defined threshold" (emphasis added), as claimed by appellant.

Appellant respectfully asserts that at least the third element of the *prima facie* case of obviousness has not been met, since the prior art reference excerpts, as relied upon by the Examiner, fail to teach or suggest all of the claim limitations, as noted above.

Group #2: Claims 13 and 30

With respect to Claim 13 et al., the Examiner has relied on Official Notice to make a prior art showing of appellant's claimed technique "wherein the user-defined threshold limitation expires after a predetermined time period." Specifically, the Examiner has argued that "it is well known to one of ordinary skill in art at the time of the invention that any variable set by the user can have time limits associated with it" because it "is just good practice to never have user inputs without time limitations on these inputs."

Appellant respectfully disagrees and asserts that the suggestion of the account holder spending limit on the ancillary card, as in Foadare, expiring after a time limit, as suggested by the Examiner, would actually prevent the account holder from being in control of the spending of the ancillary card via the set spending limits, as in Foadare. Thus, such alleged knowledge (as purported to exist by the Examiner) actually *teaches away* from the purpose of the set spending limit in Foadare's system. To this end, Foadare's spending limit on the ancillary card, in conjunction with the Examiner's Official Notice argument, fails to suggest a technique "wherein the user-defined threshold limitation expires after a predetermined time period" (emphasis added), as claimed by appellant.

Again, in view of the above, appellant thus formally requests a specific showing of the subject matter in ALL of the claims in any future action.

Appellant respectfully asserts that at least the third element of the *prima facie* case of obviousness has not been met, since the prior art reference excerpts, as relied upon by the Examiner, fail to teach or suggest all of the claim limitations, as noted above.

Group #3: Claims 14, 15, 31 and 32

With respect to Claim 14 et al., the Examiner has relied on item 116 in Figure 1 from Foadare, the description thereof excerpted below, to make a prior art showing of appellant's claimed technique "wherein the user-defined threshold limitation expires upon receipt of a key."

"If the account holder approves the increased transaction amount at step 116, the remote transaction service provider central computer

transmits an approval code for the transaction to the merchant at step 120. If the account holder does not approve the transaction at step 116, the remote transaction service provider central computer will transmit a refusal code to the merchant denying completion of the transaction at step 118.” (Foladare, Col. 4, lines 49-57, not specifically cited – emphasis added)

Appellant respectfully asserts that item 116 in Figure 1 merely indicates a step in a transaction process where an account holder has the option to approve or not approve an increased transaction amount. However, the mere disclosure of an authorization step in a transaction process in no way suggests a technique “wherein the user-defined threshold limitation expires upon receipt of a key” (emphasis added), as claimed by appellant. Clearly, an approval code or a refusal code, as disclosed by Foladare, fails to even suggest that “the user-defined threshold limitation expires upon receipt of a key” (emphasis added), in the manner as claimed by appellant.

Appellant respectfully asserts that at least the third element of the *prima facie* case of obviousness has not been met, since the prior art reference excerpts, as relied upon by the Examiner, fail to teach or suggest all of the claim limitations, as noted above.

Issue #4:

The Examiner has rejected Claims 16-17 and 33-34 under 35 U.S.C. 103(a) as being unpatentable over Hultgren (U.S. Patent No. 6,868,391), in view of Official Notice, in view of Foladare (U.S. Patent No. 5,914,472), and in further view of Holm-Blagg (U.S. Patent Application No. 2004/0030657).

Group #1: Claims 16-17 and 33-34

Appellant respectfully asserts that the subject matter of such claims is deemed novel in view of the arguments made hereinabove with respect to Issue #2, Group #1.

Appellant respectfully asserts that at least the third element of the *prima facie* case of obviousness has not been met, since the prior art reference excerpts, as relied upon by the Examiner, fail to teach or suggest all of the claim limitations, as noted above.

Issue #5:

The Examiner has failed to address Claims 35 and 36.

Group #1: Claims 35 and 36

Appellant respectfully asserts the Examiner has failed to even reject independent Claims 35 and 36. However, in view of the prior art relied on by the Examiner with respect to the remaining claims, appellant respectfully asserts that that the subject matter of Claims 35 and 36 is deemed novel in view of the arguments made hereinabove, at least in part, with respect to Issue #2, Group #1.

Appellant respectfully asserts that at least the third element of the *prima facie* case of obviousness has not been met, since the prior art reference excerpts, as relied upon by the Examiner, fail to teach or suggest all of the claim limitations, as noted above.

In view of the remarks set forth hereinabove, all of the independent claims are deemed allowable, along with any claims depending therefrom.

VIII CLAIMS APPENDIX (37 C.F.R. § 41.37(c)(1)(viii))

The text of the claims involved in the appeal (along with associated status information) is set forth below:

1. (Previously Presented) A method for providing a digital wallet for Internet Protocol (IP) usage utilizing a wireless network, comprising:
 - (a) prior to allowing wireless network voice communication and IP usage over a wireless network, receiving a request for a pre-paid debit account including payment therefor;
 - (b) prior to allowing the wireless network voice communication and the IP usage over the wireless network, enabling the pre-paid debit account in response to the request;
 - (c) collecting payment for the wireless network voice communication over the wireless network by billing against the pre-paid debit account; and
 - (d) collecting payment for the IP usage by billing against the pre-paid debit account, wherein the IP usage is carried out using the wireless network.
2. (Previously Presented) The method as recited in claim 1, wherein the request is received via a mobile cellular hand set, and the pre-paid debit account is enabled by a human operator.
3. (Original) The method as recited in claim 1, wherein the wireless network voice communication uses the wireless network via a mobile cellular handset.
4. (Original) The method as recited in claim 1, wherein the wireless network voice communication uses Wireless Application Protocol (WAP).
5. (Original) The method as recited in claim 1, wherein the IP usage includes data transfer utilizing IP.
6. (Original) The method as recited in claim 1, wherein the IP usage includes payment for goods or services utilizing IP.

7. (Previously Presented) The method as recited in claim 1, and further comprising transferring the payment from a previous pre-paid debit account before enabling the pre-paid debit account in response to the request.
8. (Previously Presented) The method as recited in claim 1, wherein a balance of the pre-paid debit account is updated in real-time.
9. (Previously Presented) The method as recited in claim 8, wherein an alert is sent to a user upon the pre-paid debit account falling below a predetermined amount.
10. (Previously Presented) The method as recited in claim 8, wherein the wireless network voice communication and the IP usage is discontinued upon the pre-paid debit account falling below a predetermined amount.
11. (Original) The method as recited in claim 1, wherein the payment is received via a credit account.
12. (Original) The method as recited in claim 1, and further comprising the step of limiting the wireless network voice communication and the IP usage based on a user-defined threshold.
13. (Original) The method as recited in claim 12, wherein the user-defined threshold limitation expires after a predetermined time period.
14. (Original) The method as recited in claim 12, wherein the user-defined threshold limitation expires upon receipt of a key.
15. (Original) The method as recited in claim 14, wherein another user may engage in the wireless network voice communication and the IP usage upon receipt of the key.

16. (Previously Presented) The method as recited in claim 1, wherein a plurality of users may engage in the wireless network voice communication and the IP usage using a single pre-paid debit account.
17. (Previously Presented) The method as recited in claim 16, and further comprising the step of limiting the wireless network voice communication and the IP usage for each of the users based on a single threshold associated with the pre-paid debit account.
18. (Previously Presented) A computer program product embodied on a tangible computer readable medium for providing a digital wallet for Internet Protocol (IP) usage utilizing a wireless network, comprising:
 - (a) computer code for receiving a request for a pre-paid debit account including payment therefore, prior to allowing wireless network voice communication and IP usage over a wireless network;
 - (b) computer code for enabling the pre-paid debit account in response to the request, prior to allowing the wireless network voice communication and the IP usage over the wireless network;
 - (c) computer code for collecting payment for the wireless network voice communication over the wireless network by billing against the pre-paid debit account; and
 - (d) computer code for collecting payment for the IP usage by billing against the pre-paid debit account, wherein the IP usage is carried out using the wireless network.
19. (Previously Presented) The computer program product as recited in claim 18, wherein the request is received via a mobile cellular hand set, and the pre-paid debit account is enabled by a human operator.
20. (Original) The computer program product as recited in claim 18, wherein the wireless network voice communication uses the wireless network via a mobile cellular handset.
21. (Original) The computer program product as recited in claim 18, wherein the wireless network voice communication uses Wireless Application Protocol (WAP).

22. (Original) The computer program product as recited in claim 18, wherein the IP usage includes data transfer utilizing IP.
23. (Original) The computer program product as recited in claim 18, wherein the IP usage includes payment for goods or services utilizing IP.
24. (Previously Presented) The computer program product as recited in claim 18, and further comprising computer code for transferring the payment from a previous pre-paid debit account before enabling the pre-paid debit account in response to the request.
25. (Previously Presented) The computer program product as recited in claim 18, wherein a balance of the pre-paid debit account is updated in real-time.
26. (Previously Presented) The computer program product as recited in claim 25, wherein an alert is sent to a user upon the pre-paid debit account falling below a predetermined amount.
27. (Previously Presented) The computer program product as recited in claim 25, wherein the wireless network voice communication and the IP usage is discontinued upon the pre-paid debit account falling below a predetermined amount.
28. (Original) The computer program product as recited in claim 18, wherein the payment is received via a credit account.
29. (Original) The computer program product as recited in claim 18, and further comprising computer code for limiting the wireless network voice communication and the IP usage based on a user-defined threshold.
30. (Original) The computer program product as recited in claim 29, wherein the user-defined threshold limitation expires after a predetermined time period.

31. (Original) The computer program product as recited in claim 29, wherein the user-defined threshold limitation expires upon receipt of a key.
32. (Original) The computer program product as recited in claim 31, wherein another user may engage in the wireless network voice communication and the IP usage upon receipt of the key.
33. (Previously Presented) The computer program product as recited in claim 18, wherein a plurality of users may engage in the wireless network voice communication and the IP usage using a single pre-paid debit account.
34. (Previously Presented) The computer program product as recited in claim 33, and further comprising computer code for limiting the wireless network voice communication and the IP usage for each of the users based on a single threshold associated with the pre-paid debit account.
35. (Previously Presented) A system including a computer readable medium for providing a digital wallet for Internet Protocol (IP) usage utilizing a wireless network, comprising:
 - (a) logic for receiving a request for a pre-paid debit account including payment therefor, prior to allowing wireless network voice communication and IP usage over a wireless network;
 - (b) logic for enabling the pre-paid debit account in response to the request, prior to allowing the wireless network voice communication and the IP usage over the wireless network;
 - (c) logic for collecting payment for the wireless network voice communication over the wireless network by billing against the pre-paid debit account; and
 - (d) logic for collecting payment for the IP usage by billing against the pre-paid debit account, wherein the IP usage is carried out using the wireless network.
36. (Previously Presented) A method for providing a digital wallet for Internet Protocol (IP) usage utilizing a wireless network, comprising:

- (a) prior to allowing wireless network voice communication and IP usage over a wireless network, receiving a request for a pre-paid debit account from a user utilizing a mobile communication unit;
- (b) prior to allowing the wireless network voice communication and the IP usage over the wireless network, receiving an account identifier associated with a previous account of the user which is adapted solely for voice communications;
- (c) prior to allowing the wireless network voice communication and the IP usage over the wireless network, authenticating an identity of the user;
- (d) prior to allowing the wireless network voice communication and the IP usage over the wireless network, enabling a pre-paid debit account;
- (e) prior to allowing the wireless network voice communication and the IP usage over the wireless network, transferring monies associated with the previous account to the pre-paid debit account;
- (f) collecting payment for the wireless network voice communication over the wireless network by billing against the pre-paid debit account; and
- (g) collecting payment for the IP usage by billing against the pre-paid debit account, wherein the IP usage is carried out using the wireless network.

IX EVIDENCE APPENDIX (37 C.F.R. § 41.37(c)(1)(ix))

There is no such evidence.

X RELATED PROCEEDING APPENDIX (37 C.F.R. § 41.37(c)(1)(x))

N/A

In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach the undersigned at (408) 971-2573. For payment of any additional fees due in connection with the filing of this paper, the Commissioner is authorized to charge such fees to Deposit Account No. 50-1351 (Order No. AMDCP005).

Respectfully submitted,

By: /KEVINZILKA/ Date: April 26, 2007

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